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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Bhogal et al.**	§	
	§	Group Art Unit: **2645**
Serial No. **09/942,796**	§	
	§	Examiner: **Gauthier, Gerald**
Filed: **August 30, 2001**	§	
	§	
For: **Voicemail/Memo Service**	§	
	§	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Certificate of Mailing Under 37 C.F.R. § 1.8(a)
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By: Rebecca Clayton
Rebecca Clayton

APPELLANT'S BRIEF (37 C.F.R. 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on December 11, 2003.

The fees required under § 1.17(c), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. 1.192(a))

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REAL PARTIES IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interference's that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interference's.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-27

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: none
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-27
4. Claims allowed: none
5. Claims rejected: 1-27

C. CLAIMS ON APPEAL

The claims on appeal are: Claims 1-27

STATUS OF AMENDMENTS

A request for reconsideration was filed by Appellants on November 3, 2003 and was entered by the Examiner.

SUMMARY OF INVENTION

A technique for storing and retrieving messages in a database using a uniform storage format that is independent of the data format used by input and retrieval devices used for such message storing and retrieval. A message received by a user (by means of a plurality of allowable

communication devices) is converted and stored in the user's designated account in a uniform storage format, where the uniform storage format is different from the format used by the communication device. In this manner, a plurality of messages from different types of communication devices can be stored in the same database regardless of the type of hardware used for input and retrieval of messages. The allowable communication devices are such things as telephones, computers and pagers, and the messages are such things as voice messages and text messages. When a message is subsequently retrieved, the message is converted from the uniform storage format into a format that is compatible with the device used to retrieve the message. A plurality of such uniform storage formats is also provided, thereby advantageously providing the ability for each designated account to store messages in a particular uniform storage format as specified for such designated account.

As shown in Figure 6, and described in the related discussion at Appellants' Specification on page 19, lines 15-26, a common database 605 is accessible by different types of communication devices such as phones and computers. As shown in Figure 7, and described in the related discussion at Appellants' Specification on page 19, lines 15-26, a common database 605 is accessible by different types of communication devices such as phones and computers. As shown in Figure 8, and described in the related discussion at Appellants' Specification on page 20, line 29 – page 21, line 20, retrieval of messages from the common database 605 is accomplished by converting the stored message from the universal storage format into a data format that is compatible with the device being used to retrieve the stored message.

ISSUES

1. Whether the Examiner properly rejected Claims 1, 3-5, 7, 9-11, 13, 15-17, 19, 21-23 and 25-27 under 35 U.S.C. § 102 as being anticipated by Irribarren et al (US 5,530,740).

2. Whether the Examiner properly rejected Claims 2, 6, 8, 12, 14, 18, 20 and 24 under 35 U.S.C. § 103 as being unpatentable over Irribarren et al (US 5,530,740) in view of Penzias (US 5,475,738).

GROUPING OF CLAIMS

Claims 1-27 do not stand or fall together, and Appellants consider the following groups of claims to be separately patentable.

Group I: Claims 1, 3-6, 13, 15-18, 25

Group II: Claims 7-12, 19-24, 26

Group III: Claim 27

Group IV: Claims 2 and 14

The claims of Group II are shown to be separately patentable by reciting the feature of "wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database and messages for each designated account are only stored in the uniform storage format specified for such designated account".

The claim of Group III are shown to be separately patentable by reciting a message having three different formats at various times throughout the claimed methodology recited therein.

The claims of Group IV are shown to be separately patentable by reciting a plurality of allowable communication devices, wherein the allowable communication devices each send data in a format different from the uniform storage format.

ARGUMENT

1. Rejection under 35 U.S.C. § 102, Anticipation

As to Group I, Appellants show that with respect to representative Claim 1, the cited reference does not teach the claimed feature of "entering the message into a designated account in the database by converting and storing the message in a uniform storage format specified for the designated account, *wherein the uniform storage format is different from a data format used by the communication device and wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database*". This claimed feature not only advantageously provides a uniform storage format that is different from the data format used by the communication device, but it goes further and also recites that there are a plurality of such uniform storage formats and that these uniform storage formats are different from one another. Importantly, the received message is entered into a designated account by converting and storing the message in the uniform storage format that is specified for such designated account. The cited reference teaches three distinct types of messages – voice, text and facsimile – and they are each stored in their own distinct format which is the same format as received. Voice messages are stored as voice messages (Claim 1). Text messages such as e-mail are stored in text format (Col. 5, lines 41-43). Facsimile messages are stored as fax image files (Col. 5, lines 12-25). To recap, the cited reference teaches that voice messages are stored as voice messages, text messages are stored as text messages, and facsimile messages as stored as fax image files. There is no teaching of a uniform storage format, as claimed, where the uniform storage format is different from a data format used by the communication device and wherein the uniform storage device is one of a *plurality of different uniform storage formats used in the database.*

In rejecting Claim 1, the Examiner states that Irribarren's teaching of a facsimile reads on the claimed message, and that this message is converted and stored in a uniform storage format ("a speech file"), wherein the uniform storage format is different from a data format ("a digital image file"). Appellants show error in this assertion as follows. Irribarren does not teach converting a facsimile file into a speech file for storage, such that the file format for the stored file is different than the received digital image file. As stated by Irribarren at Col. 5, lines 15-17:

> "recent developments have enabled facsimile (FAX) messages to be *stored as image files* with the voice message storage system." (emphasis added by

Appellants).

Thus, Irribarren teaches that fax files are stored as traditional image files (and thus are not stored as speech files, as asserted by the Examiner). Irribarren goes on to state at Col. 5, lines 20-24:

> "The user, upon the system instructing him or her that a FAX has been received, may forward the FAX to any number to which a FAX transceiver in the form of a FAX machine or other FAX receiving system is attached, forward *the FAX image file* to another voice mail address, have a hard copy printed on the office FAX machine" (emphasis added by Appellants).

Therefore, the cited reference implicitly and explicitly states that the received fax is not converted to a uniform storage format. It implicitly states this in that the FAX may be forwarded to another FAX machine or printed on the local FAX machine (without any requirement of subsequent processing or conversion – which would be required if the received fax had been converted to some other uniform format); and it explicitly states this in that the *received FAX image file* can be forwarded to another voice mail address. Therefore, contrary to the Examiner's assertion, the cited reference does not teach that a received fax is converted to a speech file for storage, such that the file format for the stored file is different from the received image file. This can also be seen in Irribarren's Abstract, where it states:

> "In summary, the present invention is a communication system comprising a voice message system for **storing and retrieving voice messages and facsimile data**, a computer database accessing system for **storing and retrieving text messages from a separate computer system and for converting[1] the text messages into voice messages**, and a personal computer which allows a user to generate and receive voices messages, facsimile data, and text messages. The systems are

[1] It should be noted that this conversion is not done prior to storage, but rather subsequent to retrieval to thereby allow a user to play/listen to their text messages (Irribarren Col. 9, lines 27-40).

integrated via a network which coordinates the functions of each individual system. Additionally, the input/output ports of the voice message system and the computer database accessing system are connected in a parallel fashion to a personal computer. In this configuration, a user may access voice messages, facsimile messages, and text messages through the personal computer." (emphasis added by Appellants)

This passage states that text messages are stored, retrieved *and converted*, yet it only states that voice and fax data are stored and retrieved. Nowhere in the cited reference is there any mention of any type of conversion of received facsimile data to a uniform storage format that is one of a plurality of different uniform storage formats.

The cited reference does state that the FAX image file is 'tagged' as a speech file such that it can be stored in a mailbox (Col. 6, lines 43-45). However, this tagging is merely the setting of an attribute associated with the file so that it can be used in the traditional voice mailbox, and does not convert the received message into a uniform storage format, wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database, as claimed. Per Dictionary.com, which is a multi-source dictionary search service produced by Lexico Publishing Group, LLC, the word 'tag' means:

n. **tag**

1. *Computer Science.*
    a. A label assigned to identify data in memory.

and tagging means:

v. **tagged, tag·ging, tags**
v. tr.

1. To label, identify, or recognize with or as if with a tag: *I tagged him as a loser.*

It is thus shown that assigning a label to the FAX digital image file by tagging is very different from the claimed format conversion. Claim 1 is thus shown to have been erroneously rejected.

Further error is shown in the rejection of Claim 1, in that the cited reference does not teach *a plurality of different* uniform storage formats (where the uniform storage format is different from a data format used by the communication device*)*. In establishing a teaching of this claimed feature, the Examiner states that the database can have text and facsimile. Appellants show that even assuming arguendo that this is true, the text is stored as a text message (i.e. in the same format for which it was received) and the facsimile is storage as a FAX digital file (i.e. in the same format for which it was received). Thus, while the cited reference may teach a plurality of storage formats which are different, it does not teach a plurality of *uniform* storage formats (which is defined in the claim to be a storage format that is *different from* a data format used by the communication device from which it was received). Both of the formats cited by the Examiner are the *same as* the data format used by the communication device.

Further with respect to Group I, such claim recites that the (received) message is entered into a designated account, and that the uniform storage format used in converting the received message is the uniform storage format that is specified for the designated account. This claimed feature advantageously allows for using different uniform storage formats for different accounts, such that a particular one of the plurality of uniform storage formats can be specified for a particular designated account. While the cited reference does mention mailboxes, there are not particular uniform storage formats that are specifically specified for such mailboxes. Restated, Irribarren's received messages are not converted to a particular storage format based on which mailbox they are to be entered into. Claim 1 specifically recites entering the message into a designated account in the database by *converting and storing the message in a uniform storage format specified for the designated account.*

Thus, the claims of Group I are shown to not be anticipated by the cited reference as there are multiple missing claimed elements/features.

With respect to Group II, representative Claim 7 recites the feature of "wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database and *messages for each designated account are only stored in the uniform storage format specified for such designated account*". In rejecting Claim 7, the Examiner equates the storing of voice messages in a mailbox as reading on this claimed feature. However, Appellants show that a key enabling feature of the teachings of the cited reference is the ability to store both traditional voice messages and FAX image files in this same mailbox (Col. 5, lines 15-28, etc.),

which are stored in a *different format* from each other. This is in contrast to and different from the claimed feature that messages for each designated account are *only stored in the uniform storage format* specified for such designated account. In summary, the cited reference teaches storing of messages in a user's mailbox in *two different types of formats,* which is contrary to only storing in the uniform storage format, as claimed. Therefore, the rejection of Claim 7 (and thus the claims of Group II) is shown to be in error.

Further with respect to Group II, and for similar reasons to those given above regarding Group I, the cited reference does not teach the claimed feature of a message being stored in a uniform storage format *that is specified for a designated account* (where the uniform storage format is one of a plurality of different uniform storage formats used in the database).

With respect to Group III, Claim 27 recites a message having three different formats at various times throughout the claimed methodology recited therein. The received message is converted from a first data format to a uniform storage format, and stored. This stored message (stored in the uniform storage format) is then retrieved and converted from the uniform storage format to another data format, wherein the another data format is different from both the first data format and the uniform data storage format. Thus, the three formats that pertain to the message are (i) first data format, (ii) uniform storage format, and (iii) another data format. The cited reference does not teach such message format transformation. Of particular noteworthiness to Claim 27 is the fact that it is *the same message that is subject to the three formats*, one format upon receipt of the message, a second format upon storage of the message, and a third format after the message has been retrieved from the database. In rejecting Claim 27, the Examiner states that the claimed receiving of a message is taught by "The system receives a user's call to retrieve messages at the user's station" (Office Action page 9, lines 7-8), that the converting of the received message into another format is taught by "a facsimile" being converted, and that converting the converted message is taught by "the message is played". This is shown to be in error, as the Examiner is using three different messages to establish three conversions. The first message being used is *a call to retrieve messages*, the second message being used is *a facsimile* (which is obviously a very different type of message from a call to retrieve messages), and the third message being a stored *voice message*. This is very different from what is being claimed, where the *same message* is the object of a conversion to a uniform storage format for storing in a database, and this *same message* is the object of a conversion from the uniform storage format to

another data format. Restated, the message as received has one format, is converted to another format and stored in a database, and is converted to yet a third format. The Examiner's allegation of the format conversion for three different types of messages (a call to retrieve a message, a facsimile and a stored voice message) simply does not teach the claimed three formats of the same message. Therefore, Claim 27 is shown to not be anticipated by the cited reference and thus has been erroneously rejected by the Examiner.

2. Rejection under 35 U.S.C. § 103, Obviousness

Appellants initially traverse the rejection of the claims in Group IV for similar reasons to those given above regarding their respective independent claims (of which these Claims 2 and 14 depend upon), and thus there are claimed elements not taught or suggested by either of the cited references.

Further with respect to Group IV, representative Claim 2 recites a plurality of allowable communication devices, and wherein the allowable communication devices *each* send data in a format *different from* the uniform storage format. In rejecting Claim 2, the Examiner asserts that Penzias Col. 4, lines 59-65 teaches this claimed feature. There, Penzias states:

> "The telephone number reflects the number to be dialed to reach the individual's voice messaging service (e.g., the AUDIX system connected to a particular PBX system), while the extension is used to identify the individual to the voice messaging service."

It is shown that a teaching of telephone and extension numbers to reach an individual's voice messaging service does not have anything to do with the claimed feature of "wherein the allowable communication devices *each* send data in a format *different from* the uniform storage format". Therefore, Claim 2 has been erroneously rejected as a prima facie case of obviousness has not been made by the Examiner[2]. In the absence of a proper *prima facie* case of obviousness,

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[2] In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id. To establish prima facie obviousness of a claimed invention, *all of the claim limitations* must be taught or suggested by the prior art. MPEP 2143.03. (emphasis added by Appellants) *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

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an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The features recited in Group IV further highlights the advantages of the claimed invention, where the uniform storage format that is used for message storage is different from the formats used by all of the allowable communication devices.

In conclusion, Appellants request that the final rejection of Claims 1-27 be reversed by the Board as having been erroneously rejected as described above.

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APPENDIX OF CLAIMS

The text of the claims involved in the appeal are:

1. A method for entering messages into a database, the method comprising:

receiving a message from a user by means of one of a plurality of allowable communication devices; and

entering the message into a designated account in the database by converting and storing the message in a uniform storage format specified for the designated account, wherein the uniform storage format is different from a data format used by the communication device and wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database.

2. The method according to claim 1, wherein the allowable communication devices include:

telephone;

mobile telephone;

computer;

PDA; and

pager, and wherein the allowable communication devices each send data in a format different from the uniform storage format.

3. The method according to claim 1, further comprising requesting personal identification information from the user, wherein the information is used to verify access rights to the database.

4. The method according to claim 1, wherein the message entered into the database is a voice message.

5. The method according to claim 1, wherein the message entered into the database is a text message.

6. The method according to claim 1, wherein the uniform storage format specified for the designated account may be one of the following:

MP3;

wave file;

AU;

WMA; and

Real Audio.

7. A method for retrieving messages from a database, the method comprising:

receiving a message-retrieval request to retrieve a requested message from a user by means of one of a plurality of allowable communication devices;

retrieving the requested message from a designated account in the database, wherein the message is stored in a uniform storage format specified for the designated account, wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database and messages for each designated account are only stored in the uniform storage format specified for such designated account;

converting the message from the uniform storage format to a data format compatible with the communication device; and

conveying the converted message to the user.

8. The method according to claim 7, wherein the allowable communication devices include:

telephone;

mobile telephone;

computer

PDA; and

pager.

9. The method according to claim 7, further comprising requesting personal identification information from the user, wherein the information is used to verify access rights to the database.

10. The method according to claim 7, wherein the message retrieved from the database is a voice message.

11. The method according to claim 7, wherein the message retrieved from the database is a text message.

12. The method according to claim 7, wherein the uniform storage format specified for the database account may be one of the following:

MP3;

wave file;

AU;

WMA; and

Real Audio.

13. A computer program product in a computer readable medium for use in a data processing system, for entering messages into a database, the computer program product comprising:

instructions for receiving a message from a user by means of one of a plurality of allowable communication devices; and

instructions for entering the message into a designated account in the database by converting and storing the message in a uniform storage format specified for the designated account, wherein the uniform storage format is different from a data format used by the communication device and wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database.

14. The computer program product according to claim 13, wherein the allowable communication devices include:

telephone;

mobile telephone;

computer;

PDA; and

pager, and wherein the allowable communication devices each send data in a format different from the uniform storage format.

15. The computer program product according to claim 13, further comprising instructions for requesting personal identification information from the user, wherein the information is used to verify access rights to the database.

16. The computer program product according to claim 13, wherein the message entered into the database is a voice message.

17. The computer program product according to claim 13, wherein the message entered into the database is a text message.

18. The computer program product according to claim 13, wherein the uniform storage format specified for the database account may be one of the following:

MP3;

wave file;

AU;

WMA; and

Real Audio.

19. A computer program product in a computer readable medium for use in a data processing system, for retrieving messages from a database, the computer program product comprising:

instructions for receiving a message-retrieval request to retrieve a requested message from a user by means of one of a plurality of allowable communication devices;

instructions for retrieving the requested message from a designated account in the database, wherein the message is stored in a uniform storage format specified for the designated account, wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database and messages for each designated account are only stored in the uniform storage format specified for such designated account;

instructions for converting the message from the uniform storage format to a data format compatible with the communication device; and

instructions for conveying the converted message to the user.

20. The computer program product according to claim 19, wherein the allowable communication devices include:

telephone;

mobile telephone;

computer

PDA;

pager; and

palm computer

21. The computer program product according to claim 19, further comprising instructions for requesting personal identification information from the user, wherein the information is used to verify access rights to the database.

22. The computer program product according to claim 19, wherein the message retrieved from the database is a voice message.

23. The computer program product according to claim 19, wherein the message retrieved from the database is a text message.

24. The computer program product according to claim 19, wherein the uniform storage format specified for the database account may be one of the following:

MP3;

wave file;

AU;

WMA; and

Real Audio.

25. A system for entering messages into a database, the system comprising:

a receiver adapted to receive a message from a user by means of one of a plurality of allowable communication devices;

a filing component adapted to associate the message with a designated account in the database; and

a storage component adapted to convert and store the message in a uniform storage format specified for the designated account, wherein the uniform storage format is different from a data format used by the communication device and wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database.

26. A system for retrieving messages from a database, the system comprising:

a receiver adapted to receive a message-retrieval request to retrieve a requested message from a user by means of one of a plurality of allowable communication devices;

a retrieving component adapted to retrieve the requested message from a designated account in the database, wherein the message is stored in a uniform storage format specified for the designated account, wherein the uniform storage format is one of a plurality of different uniform storage formats used in the database and messages for each designated account are only stored in the uniform storage format specified for such designated account;

a conversion component adapted to convert the message from the uniform storage format to a data format compatible with the communication device; and

a conveyance component adapted to convey the converted message to the user.

27. A method for storing and retrieving messages in a database, comprising the steps of:

receiving a message from a first communication device;

converting the received message from a first data format to a uniform storage format different from the first data format;

storing the converted message in the database;

receiving a message retrieval request for the message from another communication device;

retrieving the converted message from the database; and

converting the converted message from the uniform storage format to another data format, wherein the another data format has a format that is compatible with the another

communication device and different from both the first data format and the uniform storage format.

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In re application of: **Bhogal et al.**

Serial No.: **09/942,796**

Filed: **August 30, 2001**

For: **Voicemail/Memo Service**

§ Group Art Unit: **2645**
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§ Examiner: **Gauthier, Gerald**
§
§ Attorney Docket No.: **AUS920010512US1**
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By: Rebecca Clayton
Rebecca Clayton

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Sir:
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- Our return postcard.

A fee of $330.00 is required for filing an Appellant's Brief. Please charge this fee to IBM Deposit Account No. 09-0447. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Deposit Account No. 09-0447.

Respectfully submitted,

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